

REMARKS

The Examiner is thanked for the due consideration given the application.

Upon entry of this amendment, claims 1-5 and 8-10 are pending in the application. This amendment cancels claims 12 and 16-23. Claim 1 has been amended to generally incorporate subject matter from claims 16, 18 and 19. Claim 1 has additionally been amended to be drawn to a watch case. Claims 2-5, 8 and 9 have been amended to better correspond to the amendments to claim 1. Claim 10 has been amended to generally incorporate the subject matter of claims 21 and 23.

Entry of this amendment under 37 CFR §1.116 is respectfully requested because it cancels claims and places the application in condition for allowance. Alternately, the cancellation of claims reduces issues for appeal.

Rejection Under 35 USC §112, First Paragraph

Claim 23 (now cancelled) has been rejected under 35 USC §112, second paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

The Official Action asserts that the limitation "wherein the identification element is adapted to solely be supplied with energy by induction" was not described in the specification.

However, page 7, lines 12-14 of the specification clearly states: "The identification element 5 is preferably supplied with electricity solely by the inductive writing device and/or reading-writing device used to access the stored data, without calling on the watch battery."

As a result, the specification demonstrates that the inventors had possession of the claimed invention at the time the application was filed.

Rejections Based on ELLNER et al.

Claims 1-5, 17 and 18 have been rejected under 35 USC §102(e) as being anticipated by ELLNER et al. (U.S. Patent No. 6,618,328). Claims 16 and 19 have been rejected under 35 USC §103(a) as being unpatentable over ELLNER et al. in view of SEKIGUCHI (U.S. Patent 6,751,164). Claim 8 has been rejected under 35 USC §103(a) as being unpatentable over ELLNER et al. and SEKIGUCHI and further in view of SATO (U.S. Patent No. 6,657,922). Claims 9 and 22 have been rejected under 35 USC §103(a) as being unpatentable over ELLNER et al., SEKIGUCHI and SATO and further in view of KOSAKA (U.S. Patent 4,348,751). Claim 10 has been rejected under 35 USC §103(a) as being unpatentable over ELLNER et al. Claim 12 has been rejected under 35 USC §103(a) as being unpatentable over ELLNER et al., NUSSBAUM (U.S. Patent No. 5,696,741) and TARDY (U.S. Patent 6,491,424). These rejections are respectfully traversed. Claim 20 has been rejected under 35 USC §103(a) as being unpatentable over ELLNER

et al. in view of SEKIGUCHI and further in view of LAVET et al. (U.S. Patent 2,998,868). Claim 21 has been rejected under 35 USC §103(a) as being unpatentable over ELLNER et al.

These rejections are respectfully traversed.

The present invention pertains to a watch case with a middle (7) and a back that is typically illustrated, by way of example, in Figure 6 of the application, which is reproduced below.

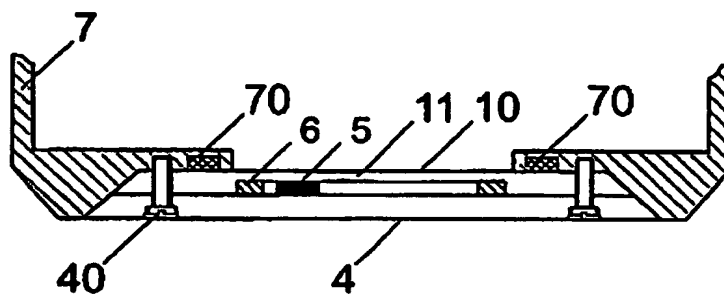
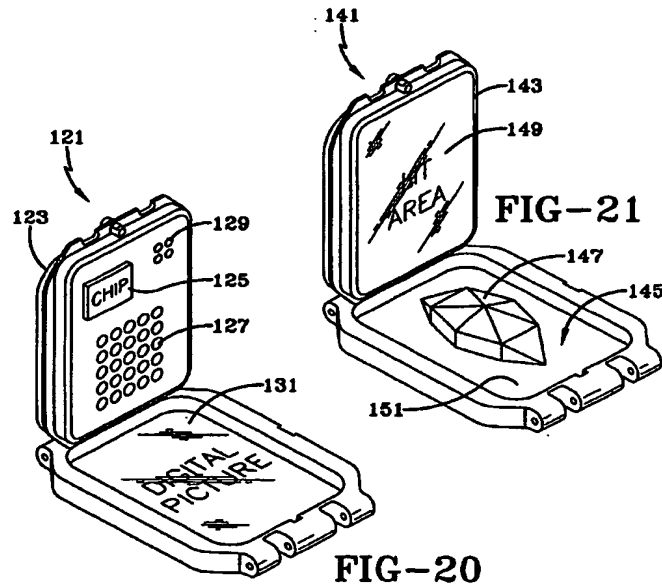


Fig. 6

Claim 1 of the present invention typically recites "a cover (4) that is screwed or clamped into the middle (7) and that defines an external surface of the back;" "a false back (11) installed against an internal surface of said cover;" and "a joint for preventing water infiltration between the middle (7) and the back, wherein an electronic identification element (5, 6) provided with an antenna is installed between said cover (4) and said false back (11)."

ELLNER et al. pertain to a watch. The Official Action refers to Figures 20 and 21 of ELLNER et al., which are reproduced below.



At page 3, lines 2-3, the Official Action states: "an identification element (125 or 147) is installed between said cover and said false back."

However, it is well-known that it is very difficult to read the information contained in the electronic identification element (transponder) when it is encapsulated in a metal case, for example, composed of a false back and a cover. The reason resides in that the metal attenuates strongly the transmission of radio frequency (RF). One of ordinary skill would thus fail to design an electronic identification element working in a false back and a metallic cover.

For example, in PARATTE et al. (JP 2002250783 A, used in rebuttal at page 13 of the Official Action), the transponder is implemented in the middle of the metal case, not between the metal cover and the false back. Furthermore, the middle of the metal case must have a slot to allow the radio frequency to pass.

【図2】

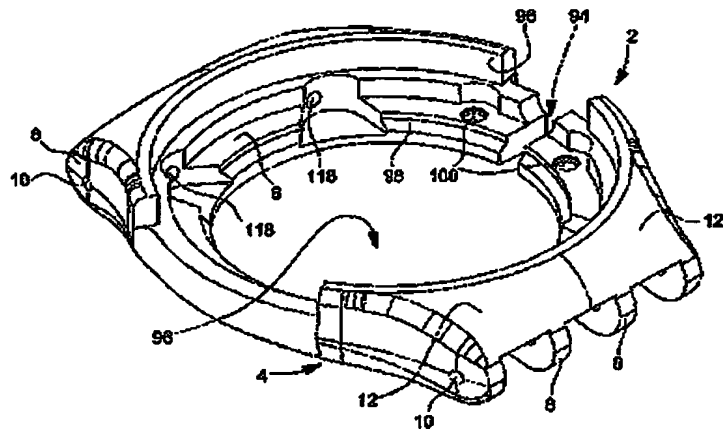


Figure 2 of PARATTE, above, shows the watch case 2 and the slot 94.

Concerning instant claim 1 of the present invention, the electronic identification element (5, 6) is an electronic identification element composed of an integrated circuit (5) and a coil (6). This identification element is completely isolated from the rest of the watch and hidden between the false back and the cover. It can only communicate with the external world by radio frequency via the antenna and when excited by an external reader.

As written at page 3 of the specification:

This approach, moreover, has the advantage of allowing an electronic identification element to be placed between the cover and the false back. This identification element can be completely hidden between the cover and the false back. It has no adverse effect on the internal or external aesthetics of the watch and is completely protected against any damage, even in the case of opening the back.

In the ELLNER et al. case, the identification element is not the same as that defined in the present invention. For example, ELLNER et al. at column 6, lines 50-65 discusses a "functional member 147" that can emit sound aroma, etc., but fails to disclose identification. The hidden compartment and its "false back" (so-called in the Official Action) have not the same functions as in the present invention.

Regarding claim 10 of the present invention, it is well known that it is very difficult to read the information contained in the transponder when it is encapsulated in a metal case, for example, composed of a false back and the cover. The reason is that the metal strongly attenuates the transmission of radio frequency. The problem is solved, in part, by utilizing a cover thickness of 5 to 7 tenths of a millimeter and by supplying energy solely by induction.

A person having ordinary skill and creativity would thus fail to design an identification element working with a false back and a metallic cover.

The secondary references applied to assert unpatentability fail to address the above-described deficiencies of ELLNER et al.

ELLNER et al. thus fail to anticipate claim 1 of the present invention. Claims depending upon claim 1 are patentable for at least the above reasons.

One of ordinary skill and creativity would fail to produce a claimed embodiment of the present invention from a knowledge of ELLNER et al. Any combination of ELLNER et al. with the secondary references would fail to induce one of ordinary skill and creativity to produce a claimed embodiment of the present invention, and a *prima facie* case of unpatentability has thus not been made.

These rejections are believed to be overcome, and withdrawal thereof is respectfully requested.

Conclusion

The Examiner is thanked for considering the Information Disclosure Statement filed January 25, 2006 and for making an initialed PTO-1449 Form of record in the application.

Prior art cited but not utilized is believed to be non-pertinent to the instant claims.

The objections and rejections are believed to have been overcome, obviated or rendered moot, and that no issues remain. The Examiner is accordingly respectfully requested to place the

application in condition for allowance and to issue a Notice of Allowability.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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